

## REMARKS

Claim 1 has been amended by incorporating the subject matter of Claim 14. Claims 16-19 and 21 has been amended by changing the dependencies. Support for the amendment to Claim 1 is presented, for example, in Claim 14 as originally filed. No new matter has been added. Applicant respectfully request entry of the amendments and reconsideration of the present application in view of the amendments and the remarks set forth below.

### Discussion of Claim Rejections Under 35 U.S.C. § 103

Claims 1-4, 7, 10, and 12-21 have been rejected under 35 U.S.C. § 103, as being unpatentable over Ishikawa et al. (U.S. Publication 2002/0042243) in view of Shimomura et al. (JP 2002/075933). Applicant respectfully submits that pending claims are allowable over the cited references as discussed below.

### Discussion of Patentability of Independent Claims 1 and 20

Claims 1 and 20 recite, among other things, "light transmittance in the light-transmitting region throughout the wavelength range of 400 to 700 nm is **50% or more**, or a thickness of the light-transmitting region is 0.5 to 4 mm, and light transmittance in the light-transmitting region throughout the wavelength range of 600 to 700 nm is **80% or more**". In rejecting the claims, the Examiner appears to read the instant features on FIG. 12 of Ishikawa. However FIG 12 of Ishikawa shows the intensity ratio (%) relative to a standard reflective spectrum. This disclosure is not equivalent to the light transmittance as recited in the claims. Accordingly, FIG 12 of Ishikawa does not lead one with ordinary skill in the art to the limitations recited in the claims.

Ishikawa does teach that the transmissivity of the window plates with respect to the measurement light be set at 22% or greater (Paragraph [0053]). However this broad transmissivity range also fails to lead one having ordinary skill in the art to the narrow range of the claimed invention. Moreover, claimed ranges provide unexpected results that support patentability. See MPEP 2144.05(II). In the present case, the evidence shows in detection of film thickness with remarkably good reproducibility. As shown in Table 1 of the present specification, Example 1 and 2 with the transmittance above 70% in the light-transmitting region throughout the wavelength range of 400 to 700 nm indicates **very good** reproducibility (indicated

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by ○ ○), Example 3 with transmittance of 51.4% at the wave length of 400 nm, which is slightly above the claimed range, shows **good** reproducibility (indicated by ○), and Comparative example 1, with transmittance of 14.7% at the wavelength range of 400 nm shows poor result. Such results are completely unexpected in view of the prior art and indicates the criticality of the cited range, thereby supporting the patentability of the claims.

As an alternative, the claims also recites that the light transmittance throughout the wave length the range of 600 to 700 nm is 80% or more. This alternative also provides unexpected results as shown by the data reported in Table 2 of Applicant's specification. In particular, Examples 4 and 5 with light transmittance on the recited region above 90% provide good detection of film thickness, while Comparative Example 2 with light transmittance about 75% does not. Shimomura does not cure the noted deficiency in Ishikawa. Therefore, Applicant respectfully submits that no *prima facie* case of obviousness has been established with respect to Claim 1 or 20, and thus each of Claims 1 and 20, is allowable over the prior art of record.

#### Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicants respectfully submit that the dependent claims are patentable over the prior art.

#### Discussion of Claim Rejections Under 35 U.S.C. § 103

Claims 1, 7, 10, and 12-21 have been rejected under 35 U.S.C. § 103, as being unpatentable over Takashi et al. (JP 11-07517) in view of Halley (U.S. Patent Number 6,361,647) and Shimomura et al. (JP 2002/075933). Applicant respectfully submits that pending claims are allowable over the cited references as discussed below.

Although, the Examiner cites "Takashi et al. (JP 11-**07517**)" in the Office Action at page 4, paragraph 5, it is assumed to be "Takashi et al. (JP 11-**77517**)" as indicated in the Office Action dated June 2, 2008. The following arguments are based on said assumption. Applicant respectfully requests confirmation.

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Discussion of Patentability of Independent Claims 1 and 20

None of Takashi, Halley, or Shimomura alone or in combination, teaches or suggests “light transmittance in the light-transmitting region throughout the wavelength range of 400 to 700 nm is **50% or more** or a thickness of the light-transmitting region is 0.5 to 4 mm, and light transmittance in the light-transmitting region throughout the wavelength range of 600 to 700 nm is **80% or more**”. Thus, the above argument is equally applicable here. Applicant respectfully requests withdrawal of the rejection.

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further view of the additional technical features, Applicants respectfully submit that the dependent claims are patentable over the prior art.

Discussion of Claim Rejections Under 35 U.S.C. § 103

Claims 1, 4, and 7 have been rejected under 35 U.S.C. § 103, as being unpatentable over Hasegawa Toru (JP 2002-324770) in view of Halley (U.S. Patent Number 6,361,647) and Shimomura et al. (JP 2002/075933). Applicant respectfully submits that pending claims are allowable over the cited references as discussed below.

Discussion of Patentability of Independent Claim 1

As Hasegawa adds nothing to support “light transmittance in the light-transmitting region throughout the wavelength range of 400 to 700 nm is **50% or more** or a thickness of the light-transmitting region is 0.5 to 4 mm, and light transmittance in the light-transmitting region throughout the wavelength range of 600 to 700 nm is **80% or more**”, the above argument is equally applicable here. Applicant respectfully requests withdrawal of the rejection.

Discussion of Patentability of Dependent Claims

The rest of the rejected claims depend from Claim 1, and further define additional technical features of the present invention. In view of the patentability of Claim 1, and in further

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view of the additional technical features, Applicants respectfully submit that the dependent claims are patentable over the prior art.

### **Discussion of Claim Rejections Under 35 U.S.C. § 103**

Claim 11 has been rejected under 35 U.S.C. § 103, as being unpatentable over Ishikawa et al. (U.S. Publication 2002/0042243) as modified by Shimomura et al. (JP 2002/075933) in view of Roberts et al. (U.S. Patent Number 6,171,181). Since the subject matter of Claim 11 has been incorporated into Claims 1 and 20 in previous submitted amendment, Applicant addresses this issue as patentability of Claims 1 and 20 and respectfully submits that Claims 1, and 20 are allowable over the cited references, as discussed below.

### **Discussion of Patentability of Independent Claims 1 and 20**

Roberts teaches a polishing pad formed as one piece article having the transparent region and the opaque region, which are integrally formed from the same material. (Column 3, lines 18-20), while Ishikawa disclose a polishing body comprising a polishing pad and window plate. Since the polishing pad is molded in as a one-piece article, Roberts could achieve reducing manufacturing steps and associates cost. (Column 4, lines 60-62) Thus, combine the Ishikawa with Roberts would destroy the features. One with ordinary skill in the art would not consider combining Roberts' teaching with the other references.

Addition to the above, Claims 1 and 20 recite, among other things, "the material for forming the light transmitting region is **non-foam**...a material for forming the polishing region is fine-cell **foam**." Accordingly, Roberts teaches away from the claimed invention as well. A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. (In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 Fed. Cir. 1997).

Moreover, As Roberts adds nothing to support "light transmittance in the light-transmitting region throughout the wavelength range of 400 to 700 nm is **50% or more** or a thickness of the light-transmitting region is 0.5 to 4 mm, and light transmittance in the light-transmitting region throughout the wavelength range of 600 to 700 nm is **80% or more**", the

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above argument is equally applicable here. Applicant respectfully requests withdrawal of the rejection.

No Disclaimers or Disavowals

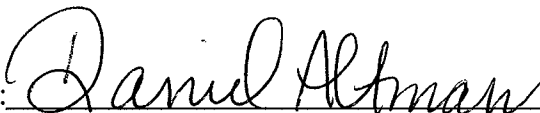
Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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